REQUEST FOR VACATION OF FINALITY

It is respectfully submitted that finality of the instant Office Action dated February 4, 2004, was entered prematurely. The Office Action dated September 10, 2003, entered a rejection of independent Claims 1, 9, and 10 under 35 U.S.C. § 103(a) over Applicant's admitted prior art, in view of U.S. Patent No. 6,462,838 (*Hirata et al.*) and U.S. Patent No. 4,513,325 (*Itoh*). It is true that the Amendment dated November 10, 2003 amended independent Claims 1, 9, and 10, but such amendments did not change the scope or content of the claims. It was argued in that Amendment that the rejection of Claims 1, 9, and 10 (*inter alia*) was defective for the reason that a *prima facie* case was not made out as to Claims 1, 9, and 10, because the there was no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings of *Hirata et al.* and *Itoh* because the patterns used in *Itoh* and those used in *Hirata et al.* are used for two totally distinct purposes.

The instant Office Action, dated February 4, 2004 (Paper No. 11), cited six (6) new references and changed the grounds for rejection of the claims based on the newly cited references. The Office Action also stated that the arguments with respect to Claims 1-4, 6, 7, 9, and 10 were considered but are moot in view of the new ground of rejection. Paper No. 11 additionally entered a rejection that was made "final". Since the new rejection of Claims 1, 9, and 10 over U.S. Patent No. 5,416,613 (*Rolleston et al.*) was not necessitated by any amendments made by Applicant, but rather was necessitated because of deficiencies in the original rejection, it is respectfully submitted that the finality of the

rejection of Claims 1, 9, and 10 was made prematurely and should be withdrawn. See MPEP § 706.07(a):

> "Under present practice, second or any subsequent action on the merits shall be final, except where the Examiner introduces a new ground of rejection that is neither necessitated by Applicant's amendment of the claims nor based on information submitted . . .." (Emphasis added.)

It is further submitted that entry of this Amendment is proper, once finality is withdrawn.

COMMENTS ON REJECTIONS

This application has been reviewed in light of the Office Action dated February 4, 2004. Claims 1, 3, 4, 6, 7, 9, and 10 are presented for examination. Claim 2 has been canceled, without prejudice or disclaimer of subject matter, and will not be discussed further. Claims 1, 6, 9, and 10 have been amended to define more clearly what Applicant regards as his invention. Claims 1, 9, and 10 are in independent form. Favorable reconsideration is requested.

Claim 6 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claim 6 has been carefully reviewed and amended as deemed necessary to ensure that it conforms fully to the requirements of Section 112, second paragraph, with special attention to the points raised on page 2 of the Office Action. Specifically, Claim 6 has been amended to recite that a patch's characteristics vary according to an image output unit signal. It is believed that the rejection under Section 112, second paragraph, has been obviated, and its withdrawal is therefore respectfully requested.

Claims 1, 3, 4, 6, 9, and 10 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,416,613 (*Rolleston et al.*), and Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Rolleston et al.* in view of U.S. Patent No. 6,310,637 (*Shimada et al.*).

As shown above, Applicant has amended independent Claims 1, 9, and 10 in terms that still more clearly define what he regards as his invention. Applicant submits that these amended independent claims, together with the remaining claims dependent thereon, are patentably distinct from the cited prior art for at least the following reasons.

The aspect of the present invention set forth in Claim 1 is an image processing method for instructing an image output unit to output onto a recording medium a reference image based on a predetermined patch pattern, and generating an image output condition of the image output unit on the basis of read data of the reference image output by the image output unit using a flatbed scanner. In the patch pattern, plural identical patches are disposed at different positions on the recording medium and at different positions in a main-scan direction and in a sub-scan direction, where the image output condition is generated using the plural identical patches disposed at different positions on the recording medium in the main-scan direction and in the sub-scan direction, and an influence of noise in the reading by the flatbed scanner is reduced by using the plural identical patches for generating the image output condition.

Among other important features of Claim 1 is that an influence of noise in the reading by the flatbed scanner is reduced by using the plural identical patches for generating the image output condition. That is, the image output condition of an image output unit of generating a reference image can be highly accurate by reducing the

influence of noises in the reading by the flatbed scanner by using the plural identical patches for generating the image output condition.

Rolleston et al. relates to a printer calibration system for calibrating a printer to produce a printer response based on a given ideal image. However, nothing has been found in *Rolleston et al.* that would teach or suggest that an influence of noises in the reading by the flatbed scanner is reduced by using the plural identical patches for generating the image output condition, as recited in Claim 1.

For at least this reason, Applicant submits that Claim 1 is clearly patentable over *Rolleston et al.*

Independent Claims 9 and 10 are apparatus and recording medium claims, respectively, corresponding to method Claim 1, and are believed to be patentable for at least the same reasons as discussed above in connection with Claim 1.

A review of the other art of record has failed to reveal anything that, in Applicant's opinion, would remedy the deficiencies of the art discussed above, as applied against the independent claims herein. Therefore, those claims are respectfully submitted to be patentable over the art of record.

The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

This Amendment After Final Action is believed clearly to place this application in condition for allowance and, therefore, its entry is believed proper under 37

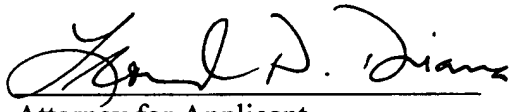
C.F.R. § 1.116. In any event, entry of this Amendment, as an earnest effort to advance prosecution and reduce the number of issues, is respectfully requested. Should the Examiner believe that issues remain outstanding, it is respectfully requested that the Examiner contact Applicant's undersigned attorney in an effort to resolve such issues and advance the case to issue.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,



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